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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,869	08/08/2001	Eugene N. Scarberry	99-31	2885

7590

08/05/2003

MICHAEL W. HAAS  
RESPIRONICS, INC.  
1501 ARDMORE BLVD.  
PITTSBURGH, PA 15221

EXAMINER

PHAM, HUONG Q

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/924,869

Applicant(s)

SCARBERRY, EUGENE N.

Examiner

Huong Q. Pham

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The means for applying a distending force (recited in claim 11) is not supported by the specification. It is unclear what this means is. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6- 9 and 11-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gusakov et al.

Claims 1-14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hon et al. Hon et al shows every claimed feature or step of claims 1, 8, 12-14 including a channel 39, a rigid part 11. For claim 8, note that “ party” appears to be misspelled. For claim 2, note that the use of hydrogel adhesive is very well known in the art, and it is obvious to use this type of adhesive for a patient contact assembly. As for claims 3 , 4 and 5, note channel 12 of

Art Unit: 3764

Hon et al. As for claim 9, note that a releasing means for delivering a release fluid will be provided when the device of Hon et al is in use. As for claim 16, the use of a syringe for delivering fluid to a channel in an electrode is very well known in the art , and therefore is not patentable over prior art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gusakov et al in view of Smuckler. In column 4 of Gusakov et al, Gusakov et al mentions the adhesive described in Smuckler. It would have been obvious to an ordinary skill in the art at the time the invention was made to use a hydrogel adhesive for a patient contact assembly. Note that the provision of a hydrogel adhesive on a surface of a patient contact assembly is very well known in the art.

Claims 3-5 ,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gusakov et al in view of Weaver et al or Szpur. While Gusakov et al does not teach a channel with multi-branches emanating from the channel, Weaver et al and Szpur teach a stem with a channel inside the stem. Weaver et al also shows that the stem and

Art Unit: 3764

channel are connected to multiple branches. In view of the teaching of Weaver et al or Szpur, it would have been obvious to an ordinary skill in the art at the time the invention was made to provide the device of Gusakov et al with a stem and a channel inside the stem for storing a fluid.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gusakov et al in view of Zenkich. While Gusakov et al does not mention about the use of a syringe for injecting fluid, Zenkich teaches this means. In view of the teaching of Zenkich, it would have been obvious to an ordinary skill in the art at the time the invention was made to provide or use a syringe to inject fluid into an electrode device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (703) 305-5129. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (703) 308 - 2698. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

Application/Control Number: 09/924,869

Page 5

Art Unit: 3764

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July 25, 2003

A handwritten signature in black ink, appearing to read 'Nicholas D. Lucchesi', written in a cursive style.

NICHOLAS D. LUCCHESI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700